

Docket No.: PC-0034 US

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By: Emma Durrell Printed: Emma Durrell

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE **RECEIVED**

In re Application of: Jennifer L. Hillman

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MAY 03 2002

Title: **TIMM8b-RELATED PROTEIN**

TECH CENTER 1600/2900

Serial No.: **09/781,117**

Filing Date: **February 08, 2001**

Examiner: **Chernyshev, O.**

Group Art Unit: **1646**

Commissioner for Patents
Washington, D.C. 20231

RESPONSE TO RESTRICTION REQUIREMENT UNDER 35 U.S.C. 121

Sir:

This paper is responsive to the Restriction Requirement and Request for Election dated March 5, 2002, setting a one (1) month term for response. Please note the period for response has been extended until May 5, 2002, by the accompanying Petition and fee.

In the Restriction Requirement, the Examiner requested Applicants to elect one of the following inventions:

Group I (claims 1-6) drawn to nucleic acids, vectors, host cells and methods of producing a protein.

Group II (claims 7-10) drawn to a method for detecting a nucleic acid.

Group III (claims 11-12) drawn to a method of screening compounds.

Group IV (claims 13-14) drawn to a purified protein.

Group V (claims 15-16) drawn to a method for screening for a ligand.

Group VI (claim 17) drawn to a method to purify antibodies.

Group VII Claim 18) drawn to an antibody.

Group IIX (claims 19-20) drawn to a method for diagnosing a disease.

The Examiner further stated that Groups II and IIX contain claims to a plurality of patentably distinct species of different diseases and conditions such as those articulated in claims 10 and 20, and that Applicants are required to elect a single disclosed species for prosecution on merits to which the claims shall be restricted if no generic claims is finally held allowable.

The Examiner also stated that Groups III and V also contain claims to a plurality of patentably distinct species of different molecules or compounds, such as those articulated in claims 12 and 16, and that Applicants are required to elect a single disclosed species for prosecution on merits to which the claims shall be restricted if no generic claim is finally held allowable.

Applicants hereby elect, with traverse, to prosecute Group I, which includes and is drawn to Claims 1-6. Applicants submit that claims 7-12 of Groups II-III represent methods of use of the polynucleotides of Group I that depend from and are therefore of the same scope as claims 1 and 3 of Group I and could be examined together with the composition of matter claims of Group I without undue burden. Applicants therefore request reconsideration of the Restriction Requirement and examination of claims 1-12 of Groups I-III. In the event the Examiner recombines the claims of Groups I-III, Applicants further elect the species of breast cancer relative to the examination of claim 10 of Group II, and the species of DNA molecules relative to the examination of claim 12 of Group III, again with traverse. The Examiner's request for election of a single disease or disorder or molecule or compound misrepresents the concept of election of species. Applicants submit that the patentable distinctiveness of either the disease conditions or the molecules or compounds are not an issue for examination purposes of the claims at issue as the claims are to a method of use of the compositions of Groups I and not to the species themselves.

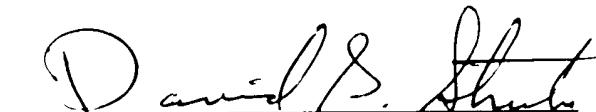
In the event that the Examiner maintains the Restriction Requirement, Applicants respectfully remind the Examiner that claims 7-12 of Groups II and III are methods of use of the polynucleotides of claims 1 and 3 of Group I that depend from and are therefore of the same scope as claim 1 and 3 and are therefore subject to rejoinder pending allowance of claims 1 and 3 in accordance with *Ochiai and Brouwer* (see Commissioner's Notice in the Official Gazette of March 26, 1996).

Please charge Deposit Account No. **09-0108** in the amount of \$110.00 as set forth in the enclosed fee transmittal letter. If the USPTO determines that an additional fee is necessary, please charge any required fee to Deposit Account No. **09-0108**.

Respectfully submitted,

INCYTE GENOMICS, INC.

Date: April 17, 2002



David G. Streeter, Ph.D.

Reg. No. 43,168

Direct Dial Telephone: (650) 845-5741

3160 Porter Drive
Palo Alto, California 94304
Phone: (650) 855-0555
Fax: (650) 849-8886